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EXHIBIT K

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HENNIGAN, BENNETT & DORMAN LLP
RODERICK G. DORMAN (SBN 96908)
ALAN P. BLOCK (SBN 143783)
KEVIN I. SHENKMAN (SBN 223315)
601 South Figueroa Street, Suite 3300
Los Angeles, California 90017
Telephone: (213) 694-1200
Facsimile: (213) 694-1234

Attorneys for Plaintiff
ACACIA MEDIA TECHNOLOGIES CORPORATION

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UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

SOUTHERN DIVISION

ACACIA MEDIA TECHNOLOGIES CORPORATION,

Plaintiff,

vs.

NEW DESTINY INTERNET GROUP, et. al.,

Defendants.

AND ALL RELATED CASE ACTIONS.

Case No. SACV 02-1040 JW (MLGx)

PLAINTIFF ACACIA MEDIA TECHNOLOGIES CORPORATION'S COMBINED OPPOSITION TO:

(1) CLAIM CONSTRUCTION BRIEF OF AEBN, INC.; ADEMIA MULTIMEDIA, LLC; AUDIO COMMUNICATIONS, INC.; GAME LINK, INC.; INNOVATIVE IDEAS INTERNATIONAL; LIGHTSPEED MEDIA GROUP, INC.; NEW DESTINY INTERNET GROUP, INC.; VS MEDIA, INC.; AND

(2) CLAIM CONSTRUCTION BRIEF OF IWI AND OFFENDALE

DATE: February 6, 2004
TIME: 10:00 a.m.
CTRM: Hon. James Ware

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I. INTRODUCTION

Acacia hereby provides its consolidated opposition to both of defendants' Claim Construction Briefs. In doing so, Acacia largely ignores portions of the first fourteen pages of Fish and Richardson's brief devoted to name calling, charges of inequitable conduct, and a rambling discourse alleging general invalidity without reference to any particular patent claim.

Defendants' proposed constructions of the eight phrases at issue are meritless and invite legal error. For instance, defendants argue that the phrase "remote locations" means "more than one location selectable by the user." In addition to being contrary to the ordinary meaning of these terms and improperly importing limitations from the specification, the Patent Examiner explicitly rejected defendants' construction and the inventors explicitly disavowed this construction during the prosecution of a related patent application. If the Court adopts defendants' construction of "remote locations," it would be reversing the Patent Examiner's explicit construction.

Additional errors appear in defendants' other proposed constructions. For example, defendants improperly construe the "library means for storing . . ." as a means-plus-function claim term, even though defendants admit the word "library" communicates structure. Moreover, the term "library" provides sufficient structure to perform the function of "storing," i.e., "providing storage room for." This is not a means-plus-function phrase.

There are two other phrases which the parties agree are means-plus-function claims—"identification encoding means" and "compressed data storing means." The parties to disagree are the claimed functions, whether structure is disclosed in the specification, and whether the structure is disclosed in the specifications sufficiently identified with the means. Acacia will demonstrate that sufficient structure is disclosed and identified in the specification for each of these limitations.

Defendants present inconsistent constructions for two of the phrases in claim

41—"storing items having information. . ." and "storing as a file . . .," both of which are legally erroneous. Both phrases recite "acts" and no claim in which those phrases appear uses the words "step for . . ." Nevertheless, defendants IWI/Offendale, in their brief, argue that the phrase "storing, as a file. . ." should be construed as a step-plus-function claim limitation, which it is not. Contrastingly, the Fish & Richardson defendants do not contend any step-plus-function claim exists in the '992 patent; they treat the phrase "storing items having information. . ." like any other phrase in a method claim. In doing so, however, they erroneously construe the phrase contrary to the ordinary and customary meaning of the terms in the phrase and they improperly import limitations from the specification into the claim. Similarly, defendants' construction of the remaining two claim phrases is also erroneous. Defendants' proposed construction of "unique identification code" is contrary to the ordinary and customary meaning of the terms of the phrase (and the phrase itself) and it seeks to import limitations from the specification into the claim.

Defendants' proposed construction of "sequence of addressable data blocks" is incorrect and ignores the fact that the inventors acted as their own lexicographers in defining this phrase, which is different from the ordinary meaning of the terms of the phrase.

The Court should therefore reject defendants' proposed constructions and adopt Acacia's, as set forth in its opening brief.

II. REBUTTAL TO DEFENDANTS' DESCRIPTION OF THE '992 PATENT, ITS PROSECUTION HISTORY, AND THE PRIOR ART

A. None of the Prior Art Discussed by Defendants Will Invalidate Any Claim of the '992 patent

It is legally irrelevant whether there were "dozens" of publicly-available references disclosing various aspects of video and audio-on-demand systems in 1991 as defendants contend. If this briefing was directed at issues of patent validity, which it is not, the legally relevant inquiry would be whether defendants can show by clear and convincing evidence that these references by themselves, or in combination, disclose each and every element of the claims of the '992 patent. As set forth in the accompanying footnote, defendants fail to show that elements disclosed in claims of the '992 patent are found in the prior art.[1]

B. The Convenience to the User is Not a Limitation of Any of the Claims of the '992 Patent

Pages 8-11 of the Fish & Richardson brief construct a false and irrelevant syllogism. Defendants argue: (i) the inventors rested patentability on two novel features providing convenience to the user, (ii) those features were discussed by the inventors during the prosecution process, (iii) prior art discloses those features, and (iv) the'892 patent is therefore invalid. Defendants' argument is wrong factually and legally. The '992 patent lists a host of separate "objects" of the invention (not just two) which are summarized in the "Background of the Invention" section of the patent ('992 patent, 1:57-2:15), and are discussed throughout the specification of the patent. Moreover, the two features identified by defendants therefore do not limit the scope of claim coverage. Rolls-Royce Ltd. and Renishaw, PLC v. GTE Valeron Corp., 800 F.2d 1101, 1108 (Fed. Cir. 1986) ("Reference to an object does not constitute in itself a limitation in the claims"); E-Pass Technologies, Inc. v. 3Com Corp., 343 F.3d 1364, 1370 (Fed. Cir. 2003) ("An invention may possess a number of advantages or purposes, and there is no requirement that every claim directed to that invention be limited to encompass all of them."); Rodime PLC v. Seagate Technology, Inc., 174 F.3d 1294, 1303 (Fed. Cir. 1999) ("A claim need not claim every function of a working device. Rather, a claim may specify improvements in one function without claiming the entire machine with its many functions."). The legal irrelevance of defendants' argument on this subject is demonstrated by the fact that the defendants spend four pages of their brief describing selected portions of the prosecution history of the '992 patent. They do so, however, without referring to the specific claims that are being discussed[2] by the applicant and the examiner, and without ever showing that any of the inventors' statements evidence a clear disavowal of particular claim scope. Teleflex, Inc. v. Ficosa North America Corp., 299 F.3d 1313, 1327 (Fed. Cir. 2002) ("We hold that claim terms take on their ordinary and accustomed meanings unless the patentee demonstrated an intent to deviate from the ordinary and accustomed meaning of a claim term by redefining the term or by characterizing the invention in the intrinsic record using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope.").

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[1] The BBS system article in Byte merely discusses in general terms the state of the BBS business; it does not discuss or disclose the technology for creating, downloading, and playing back compressed digital video or audio from a BBS service. (Exhibit V to the Miller Declaration). The Amiga World article reviews four different computer utilities (applications) used to compress and archive text files—it does not even discuss compressed video or audio. (Exhibit W to the Miller Declaration).

The J.C. Penney system shown in Wilson, U.S. Patent No. 5,195,092 (See, Exhibits H and J to the Miller Decl.) is inapplicable to the claims of the '992 patent, because it lacks many of the elements/acts required by the claims. Among other omissions, Wilson does not disclose a library means or a source material library. The production facility of Wilson, is not a library; it is a software application that is to prepare the presentations by capturing and storing images in digital form and performing manipulations and compression on the image. (Exhibit H to Miller Decl., at 13:43-50).

The remaining four references discussed by the defendants—Lang, Walter, Abraham, and Monslow—were all considered by the Examiner while prosecuting the '992 patent and the Examiner issued the claims over these references. Thus, the Examiner believed that none of these references, either alone, or in combination with another reference, discloses all of the limitations of the claims of the '992 patent. American Hoist & Derrick Co. v. Sowa & Sons, Inc., 725 F.2d 1350, 1359 (Fed. Cir. 1984) ("When no prior art other than that which was considered by the PTO examiner is relied on by the attacker, he has the added burden of overcoming the deference that is due to a qualified government agency presumed to have properly done its job.").

[2] Had defendants identified the claims being discussed by the inventors when arguing patentability to the Examiner, the Court would see that many of the statements are made with respect to original claim 18. Original claim 18 (which became claim 19 on the '992 patent) contains specific language which specified that the remote location is selectable by the user. No such language exists in original claims 1 and 22 or independent claims 1, 25, 41, and 54 of the '992 patent.

III. THE COURT SHOULD REJECT DEFENDANTS' PROPOSED CONSTRUCTIONS OF THE EIGHT CLAIM PHRASES

A. The Phrase "Remote Locations" Does Not Mean More Than One Location Selectable By The User

The terms of the phrase "remote locations" mean "positions or sites distant in space from the position(s) or site(s) of the transmission system."

Defendants' proposed construction of "remote locations"—more than one location selectable by a user—is demonstrably incorrect. It is consistent with the ordinary and accustomed meaning of the phrase "remote locations," it ignores the claim language which specifies that the information is provided to a location remote from the transmission system, not the user, it ignores the doctrine of claim differentiation and the prosecution history conclusively establishes that the meaning of the phrase "remote locations" is not and cannot be the definition proposed by defendants. The Patent Examiner, when examining the application for U.S. Patent No. 6,002,720, which is related to the '992 patent considered and rejected the construction of "remote locations" being proposed by defendants here.

1. Defendants' Proposed Construction Is Inconsistent with the Ordinary and Customary Meaning of "Remote Locations" As Used in the Claims

Defendants' proposed construction is inconsistent with the ordinary and customary meaning of "remote locations," which is presumed to apply. CCS Fitness, Inc. v. Brunswick Corp., 288 F.3d 1359, 1366 (Fed. Cir. 2002). Moreover, in determining the ordinary and customary meaning of a claim term, "the context of the surrounding words in a claim also must be considered." Arlington Industries, Inc. v. Bridgeport Fittings, Inc., 345 F.3d 1318, 1325 (Fed. Cir. 2003).

As the inventors state in the "Background of the Invention" section of their patent, one of the objects of the present invention is to "provide a picture and sound transmission system which allows the user to remotely select audio/video material from any location that has either telephonic service or a computer." ('992 patent, 1:62-65). "Remote locations" clearly means locations remote from the transmission system, not remote from the location of the requesting user, which defendants contend. The preamble of representative claim 1 of the '992 patent makes that clear:

> "What is claimed:
>
> 1. A transmission system for providing information to be transmitted to remote locations, the transmission system comprising: . . .

Claims 1, 19, 41 and 47 of the '992 patent describe a transmission system for providing information to be transmitted to remote locations. It could not be more clear from the context of the claims that the "remote locations" are locations remote from the transmission system.

Defendants argue that "remote locations" means "more than one location selectable by the user." No dictionary definition of remote locations includes limitations regarding selectability by a user. Further, defendants' definition makes no reference whatsoever to distance or space. Still further, if defendants' claim construction was adopted it would contradict the ordinary meaning of the phrase "remote locations" as used in representative claim 1. Under defendants' definition, a "location selectable by the user" could be the location of the transmission system, itself, which of course is not a remote location from the transmission system. Thus, defendants' proposed definition renders the claim limitation "remote" meaningless and therefore violates a fundamental principle of claim construction by "reading out" an express claim limitation. Texas Instruments Inc. v. U.S. Internat'l Trade Comm'n, 988 F.2d 1165, 1171(Fed. Cir. 1993) ("[T]o construe the claims in the manner suggested by TI would read an express limitation out of the claims. This, we will not do because 'courts can neither broaden nor narrow claims to give the patentee something different than what he has set forth.'"); Lockheed Martin, Corp. v. Space Systems/Loral, Inc., 249 F.3d 1314, 1324 (Fed. Cir. 2001) ("In this case, the District Court erred by improperly broadening the scope of a claimed function by 'reading out' the limitations contained in the claim language.'"). This, in and of itself, should be enough to show that Defendants' construction is incorrect.

As shown in Acacia's opening brief, there is a heavy presumption that the phrase "remote locations" is construed as having its ordinary and customary meaning when read in the context of the claim language. (Op. Br. P. 11). Acacia's proposed construction is consistent with this meaning and defendants have not overcome this heavy burden.

2. Defendants Are Improperly Attempting to Import Limitations from Claims 19 and 47 into Claims 1 and 41

Defendants argue that the meaning of the phrase "remote locations," as used in claims 1 and 41, can be determined from examining the use of "remote locations" in claims 19 and 47. Claims 19 and 47 actually confirm Acacia's proposed construction.

Claims 19 and 47, unlike claims 1 and 41, contain explicit limitations that information be sent to "remote locations selected by the user.[3] Contrastingly, claims 1 and 41 do not contain any explicit limitations or terms regarding a user, a user request, a user selecting a remote location, or a receiving system and thus are not limited to user-selected locations—the only limitation is that the location be remote from the transmission system. This is confirmed by the Examiner's construction of claim 33 in the '720 patent application, as discussed below.

Defendants are arguing that the Court should import a limitation from claims 19 and 47 (that a user request specify a selected remote location) into claims 1 and 41, which do not contain such a limitation. Adoption of defendants' construction would violate the doctrine of claim differentiation. "It is settled law that when a patent claim does not contain a certain limitation and another claim does, that limitation cannot be read into the former claim in determining either validity or infringement." SRI International v. Matsushita Electric Corporation of America, 775 F.2d 1107, 1122 (Fed. Cir. 1985); Amgen, Inc. v. Hoescht Marion Roussel, Inc., 314 F.3d 1313, 1325 (Fed. Cir. 2003). Defendants cannot rewrite the claim phrase "remote locations" to add limitations that simply do not exist in the claim. Texas Instruments, 988 F.2d at 1171 ("'courts can neither broaden nor narrow claims to give the patentee something different than what he has set forth.'"); Hoganas AB v. Dresser Industries, Inc., 9 F.3d 949, 950, 1578 (Fed. Cir. 1993) ("It is improper for a court to add 'extraneous' limitations to a claim, that is, limitations added 'wholly apart from any need to interpret what the patentee meant by particular words or phrases in a claim.'"); Renishaw PLC v. Marposs Societa A'Per Azoni, 158 F.3d 1243, 1249 (Fed. Cir. 1995) ("We know of no principle of law which would authorize us to read into a claim an element which is not present, for the purpose of making out a case of novelty or infringement. The difficulty is that if we once begin to include elements not mentioned in the claim in order to limit such claim . . . , we should never know when to stop.") (citing McCarty v. Lehigh Valley R.R., 160 U.S. 110, 116 (1895)).

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[3] Defendants argue that, in claim 19, the term "remote locations" used in the preamble, provides antecedent basis for the phrase "one of the remote locations selected by a user" in the "sending a request. . ." claim step. Defendants focus on the portion of this phrase "the remote locations," but ignore the portion "selected by the user." The phrase "one of the remote locations selected by a user" is part of the step of "sending a request . . ." Therefore the antecedent basis for the phrase "selected by the user" is found in the phrase "sending a request," not in the phrase "remote locations," because the identity of the location selected by the user is in the request which is sent by the user.

The use of the phrase "remote locations" by the inventors in its ordinary and accustomed meaning with reference to the transmission system described in claims 1 and 41 is further supported by the use of differentiating words in other claims. In claims 19 and 47, the inventors intended to claim a method and system which was limited so that the request sent by the user would identify a reception system at a selected remote location and the information would be transmitted to this location. The inventors still used the phrase "remote locations" in its ordinary and customary manner, but added words which create limitations that the request would include the identity of the reception system at a remote location selected by the user and that the information would be sent to, stored, and played back at the receiving system at the selected remote location. Claims 19 and 47 convey this meaning sought by the inventors using the ordinary and customary meaning of "remote locations" proposed by Acacia together with these added words.

In claims 25 and 54, the inventors did not intend for the remote locations to be remote from the transmission system, but instead intended these locations to be remote from the source material library. Had they used the same language in the preamble that they had used in the preamble of the other claims, which used the phrase "remote locations" when discussing the transmission system, their claim would have been construed, like claims 1, 19, 41, and 47, as being locations remote from the transmission system. Therefore, the inventors used different language in claims 25 and 54 to specify what they intended to claim—"a location remote from the source material library."

3. The Patent Examiner Rejected and the Inventors Disavowed Defendants' Construction of "Remote Locations" During the Prosecution of U.S. Patent No. 6,002,720

The prosecution of the '720 patent confirms and is dispositive of Acacia's construction of "remote locations."

The following is a description of the relevant events and statements made during the prosecution of the '720 patent. On April 10, 1996, the inventors filed the application for the '720 patent. In a preliminary amendment filed on that same day, the inventors set forth the claims that they sought to obtain in the '720 patent. In particular, the inventors asserted claims 33-42. (Exhibit 15 to Supplemental Appendix).

Original claim 33[4] of the '720 patent application was similar to claim 1 of the

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[4] Because the inventors filed the '720 patent application as a continuation of the '992 patent application, the numbering of the claims starts where the numbering of the claims in the original '992 patent application ended. Thus, claim 33 of the '720 patent is the first claim in the application and became claim 1 of the '720 patent.

'992 patent, however, it claimed a plurality of library means and eliminated the ordering means and compression means. Like claim 1 of the '992 patent, claim 33 stated that the transmission system provides information to remote locations.

On July 24, 1997, the Examiner rejected original claims 33 and 34 over Wilson, U.S. Patent No. 5,195,092, stating, among other things, that Wilson shows a "transmission system for providing information to be transmitted to remote locations." On November 21, 1997, the inventors responded to the Examiner's rejection and argued that claim 33 was distinguished from Wilson, because Wilson requires that the subscriber be physically present at the location to which information is transmitted, whereas in the present invention, the user does not have to be connected by telephone when information is transmitted from the library to the selected remote location. (Exhibit 16 to Supp. App.)

On February 10, 1998, the Examiner responded to the inventors' comments by stating that the inventors' arguments were not persuasive, because the features on which the inventors' rely to distinguish from Wilson are not recited in the claims and the Examiner will not read these limitations from the specification into the claims:

> Regarding claims 33 and 34, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *"a flexible system in which a user can remotely access information. That is, the user can request transmission of information to a site remote from the requesting site. Additionally, with the present invention the user does not have to be connected by telephone when information is transmitted from the library to the selected remote location."*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. In re Van Guens, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(February 10, 1998 Office Action at 4, Exhibit 17 to Supp. App.; emphasis supplied)

Thus, the inventors, in an effort to overcome the Wilson reference made the very same argument regarding the interpretation of the phrase "remote locations" that the defendants make now—that the phrase is construed as requiring user-selectable locations. The Patent Examiner rejected this argument (defendants' argument) and held that this phrase cannot be so interpreted, because, to do so, would improperly import limitations from the specification into the claim. The Court must give weight to the Examiner's determination that the phrase "remote locations," as used in original claim 33 of the '720 patent (and the claims of the '992 patent) does not mean that the locations are "user-selectable." See, American Hoist, 725 F.2d at 1359 (patent examiner entitled to the deference due to a qualified government employee).

It must be noted that, although defendants give the appearance in their brief that they are providing a full recounting of the statements and events which occurred during the prosecution of the '720 patent (they include three very lengthy quotes from the prosecution history), defendants omit from their brief this quote of the Examiner's comments in the February 10, 1998 Office Action and the inventors' full response. Therefore, defendants' description of the '720 patent prosecution history is misleading and disingenuous.

In response to the Examiner's finding regarding the construction of the phrase "remote locations," the inventors, on August 6, 1998, filed an amendment to original claim 33 to explicitly state that the information is transmitted to a remote location selected by the user:

> 33. (Amended) A transmission system responsive to input from a user positioned at an accessing location for [providing] transmitting information [to be transmitted to remote locations,] to a remote location selected by the user, the transmission system comprising:
>
> * * *
>
> transmitter means, coupled to the conversion means, for transmission of the formatted data to [one of the remote locations] the remote location selected by the user, wherein the remote location may be different from the accessing location.[5]

[5] When amending claims during prosecution, the inventors indicated the text to be deleted with brackets [ ] and indicated text to be added with underlines.

(August 6, 1998 Response to Office Action at 1-2; Exhibit 18 to Supp. App.)

The inventors explained that they amended their claims to "clarify that the remote location to which the information is transmitted is different from the accessing location at which the user is positioned when making the request." (August 6, 1998 Response to Office Action, at 6; Exhibit 18 to Supp. App.) See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 535 U.S. 722, 734 (2002) ("A rejection indicates that the patent examiner does not believe the original claim could be patented. While the patentee has the right to appeal, his decision to forgo an appeal and submit an amended claim is taken as a concession that the invention as patented does not reach as far as the original claim.")

Thus, the inventors made a clear disavowal of claim language regarding the meaning of the phrase "remote locations" during the prosecution of the '720 patent—they disavowed the construction of "remote locations" which required that the locations be selectable by the user and agreed with the Examiner that the phrase "remote locations" by itself does not require that the location be user-selectable.

4. The Inventors Did Not Make a Clear Disavowal of Claim Scope in the Specification or Prosecution History of the '992 Patent

The specification of the '992 patent confirms Acacia's construction of "remote locations." Defendants ignore the portions of the specification which describe embodiments of the invention which do not require that the remote location of the reception system where the information is to be sent is selectable by the user. The specification states that "[t]he transmission system 100 of the present invention preferably further includes transmitter means 122, coupled to the compressed data library 118, for sending at least a portion of a specific file to at least one remote location." ('992 patent, 15:61-65; See also, 2:25-48; 18:46-50). Thus, the inventors did not limit their specification to just one invention—they described many embodiments of their invention of different scope, including ones in which the transmission is to a reception system at a remote location, without any limitation on the remote location being user-selectable. By providing a number of embodiments in the specification and by not limiting the specification to an invention that is narrower than the claim language might imply, the inventors have supported embodiments of their invention where the remote locations are not selectable by the user, thereby not limiting their disclosure to only remote locations that are user-selectable. See, Mantech Environmental Corp. v. Hudson Environmental Services, Inc., 152 F.3d 1368, 1374 (Fed. Cir. 1998) ("If the written description supports the definition of the term that is apparent from the claim limitation, then reading in a further limiting definition would be improper."); Specialty Composites v. Cabot Corp., 845 F.2d 981, 987 (Fed. Cir. 1988) ("Where a specification does not require a limitation, that limitation should not be read from the specification into the claims.").

Defendants' proposed construction is therefore incorrect for the additional reason that it improperly seeks to import limitations from the specification into the claims. See, Sjolund v. Musland et. al., 847 F.2d 1573, 1581 (Fed. Cir. 1988) ("[W]hile it is true that claims are to be interpreted in light of the specification and with a view to ascertaining the invention, it does not follow that limitations from the specification may be read into the claims.") This is why the Examiner in the '720 patent refused to adopt the construction proposed now by the defendants. (Exhibit 17 to Supp. App.)

There is no question that the inventors disclosed other embodiments for their invention, one of which included a user being able to select the location to which the transmission would be made. There is also no question that the inventors distinguished prior art references on this and on many other grounds in the specification and the prosecution history.[6] This was proper, because the inventors had pending claims, such as original claim 18 (claim 19 of the '992 patent), which specifically stated that the transmission is to remote locations selected by the user. But this does not mean that the inventors meant to limit their invention in its entirety to "user selectable" remote locations or that the inventors intended to disavow claim scope and require that the phrase "remote locations" should not be given its ordinary and customary meaning. See, Schwing GMbH v. Putzmeister Aktiengesellschaft, 305 F.3d 1318, 1325 (Fed. Cir. 2002) (prosecution history statements did not provide a narrowing definition with reasonable clarity and deliberateness where patentee identified several disadvantages of prior art reference); Read Corp. v. Portec. Inc., 970 F.2d 816, 824 (Fed. Cir. 1992) ("Read distinguished . . . the Deister reference because of a wealth of differences. . . . Thus, any estoppel created by Portec's argument encompasses all of these combined distinctions of Deister and not an estoppel respecting each of the individual differences.")

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[6] Walter—See, '992 patent, 1:23-26; PTMS, Miller Decl., Exhibit B at 157-158; Lang—See, '992 patent, 1:51-56; PTMS, Miller Decl., Exhibit B at 154-155 and

Nowhere do the inventors state, nor is it implicit, based on any statement, that the claim phrase "remote locations" must take on a meaning different than its ordinary and customary meaning or that this phrase means "more than one location selected by the user." Defendants have therefore failed to show through their many citations to the specification and to the prosecution history, that the inventors explicitly limited their invention to a single embodiment—i.e., one in which the user must select the remote location.

B. The Phrase "Library Means For Storing Items Having Information" Is Not a Means-Plus-Function Limitation

The parties have two disputes relating to this phrase. First, they dispute whether the phrase should be construed as a means-plus-function limitation. Second,

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September 30, 1991 Response to Office Action, Miller Decl., Exhibit B at 208-209; Monslow—See, '992 patent, 1:30-38; PTMS, Miller Decl., Exhibit B at 155-156; Fenwick—See, PTMS, Miller Decl., Exhibit B at 159-60; September 30, 1991 Response to Office Action, Miller Decl., Exhibit B at 212-214.

even if this Court found that the phrase needed to be construed as a means-plus-function limitation, the parties dispute the proper construction such an analysis would provide.

Acacia intends the phrase "library means for storing items having information" is not a means-plus-function limitation, because sufficient structure for performing the claimed function is disclosed in the claim. This phrase is therefore properly construed as:

> a place where items of information are kept or which constitutes a collection of items of information (where items are units or members of a group or groups and information is any meaning assigned to data by known conventions).

Defendants admit that the claim language provides structure—the word "library" is admittedly "a structural term." (Fish & Richardson Op. Br. P. 30). They contend the phrase should nevertheless be construed as a means-plus-function limitation because the claim does not recite "sufficient structure" to perform the functions disclosed. Importantly, this argument is premised on defendants' selection of a definition of "library" that is unnecessarily restrictive.

To determine whether the claim phrase is a means-plus-function limitation, the Court must first determine what function is described in the claim, and then determine whether the claim itself provides sufficient structure for performing the claimed function. Envirco Corp. v. Clestra Cleanroom, Inc., 209 F.3d 1360, 1365 (Fed. Cir. 2000).

The parties disagree on the construction of the claimed function—"storing items containing information." Acacia contends that the ordinary and customary meaning of the term "storing," as used in the claim phrase is "providing storage room for." Acacia finds support for this definition in Webster's and showed in its opening brief how this definition for the term "storing" is consistent with the use of the term "storing" in the specification of the '992 patent. (Acacia's Brief at 19:18-28).

Defendants contend that "storing," as used in the claim phrase is an act—"to place or leave in a location for later use." Although this is one meaning of the term "storing," provided in Webster's, it is not the correct meaning for this term in the context of the claim language "library means for storing," and if adopted would create a redundancy. According to defendants' definition for "storing," the library means is not a place, but instead is some device used to place items in a (library) location for later use, (i.e., library means for placing items in a library). There is nothing in the specification that discusses or discloses such a placement device, and therefore defendants' definition of "storing" cannot be correct. Renishaw, 158 F.3d at 1250 ("[a] common meaning, such as one expressed in a relevant dictionary, that flies in the face of the patent disclosure is undeserving of fealty.") Acacia's definition—providing storage room for—is therefore the correct construction of "storing."

Using its erroneous definition of storing, defendants construe the phrase "storing items containing information" as "the library means must have items containing information that may be readily accessed for use by the transmission system, i.e., the library means is part of the transmission system." (Defs' Brief at 30:10-13). Defendants have transparently crafted a definition to suit their non-infringement purposes, but which they failed to support in their brief and which has absolutely no support in the specification or claims of the '992 patent or in the dictionary definition which they have selected. For example, defendants' construction uses the phrase "readily accessed," but this phrase does not appear in the dictionary definition for "storing" (which says "for later use") and does not appear either explicitly or implicitly in the specification or claims. Further, defendants' construction is inconsistent with their own selected dictionary definition, because it eliminates the act of "placing."

Defendants next argue that the claim does not recite sufficient structure to perform the function, as erroneously construed by defendants. Defendants argue that a "generic library" is a library, as defined in Webster's as "a room, a section or series of sections in a building, or a building itself given over to books, manuscripts, musical scores, or other literary and sometimes artistic materials (as paintings or musical recordings) usually kept in some convenient order for use but not for sale." This definition of library is not consistent with the specification of the '992 patent, which says nothing about the library being limited to a building, a part of a building, or a room. In selecting their definition of "library," defendants ignore definition 1(b)(1) in the Webster's dictionary, which is consistent with the specification: "a collection of books, manuscripts, or other literary materials kept (as in a library) for convenient use, study or enjoyment." (Defs' Exhibit Q at 542).[7]

Defendants further argue that their alleged construction is supported by statements made by the inventors regarding Lang, U.S. Patent No. 4,963,995 during prosecution of the '992 patent. In particular, defendants argue that the inventors' statements confirm that the library means is "readily accessible" by the transmission system. (Defs'. Brief at 31:15-18).

Nowhere in their statements to the Patent Office did the inventors state that the library means must be "readily accessible" by the transmission system. Lang discloses nothing more than an improved VCR, which plays one cassette at a time. (See, Exhibit C to Miller Decl.) As such, Lang does not disclose (among many other things): (1) a library for storing items or (2) an identification encoding means for retrieving information and for assigning a unique identification code. (Id.) This is exactly what the inventors explained in their PTMS and in response to the Office Action dated August 29, 1991. (See, PTMS, at 6-7; Exhibit 2 to Acacia's App. at 133-134; Sept. 30, 1991 Response, at 18-19; Exhibit 2 to Acacia's App. at 195-196). Thus, the inventors' statements to the Patent Office mean nothing more than the fact that Lang does not disclose a library means or an identification encoding means. No effect on the meaning of the terms "library" or "storing" should be attributed to these statements, because these statements do not evidence a clear disavowal by the inventors of claim scope. Schwing, 305 F.3d at 1325; Read Corp., 970 F.2d at 824.

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[7] The dictionary definition for "library" in the version of Webster's used by Acacia is even more consistent with the specification: "**1a**: a place in which literary, musical, artistic, or reference materials (as books, manuscripts, recordings, or films) are kept for use, but not for sale. **b**: a collection of such materials." (Acacia's Exhibit 12 at 537).

Thus, as set forth by Acacia in its opening brief, the claimed function for the claim phrase "library means for storing items containing information" is "providing storage room for items containing information." A "library," which is "a place where materials are kept or a collection of such materials," is sufficient structure for performing this function. Accordingly, this claim phrase is not a means-plus-function limitation.

C. Even if Construed as a Means-Plus-Function Limitation, Defendants' Construction of Library Means is Erroneous

Even if the Court were to find that this phrase is construed as a means-plus-function claim limitation, the Court would arrive at the conclusion that the library means is a library, i.e., a place where materials are kept or a collection of such materials. (Acacia's Brief at 19:4-16). The '992 patent specification discloses a source material library 111. ('992 patent, 6:8-10). The source material library is a library which stores source material for use by the transmission system. The source material is described as: "television programs, movies, audio recordings, still pictures, files, books, computer tapes, computer disks, documents of various sorts, musical instruments, and other physical objects." ('992 patent, 6:10-15). The source material are in different media formats -- "digital or analog audio and video tapes, laser disks, film images, optical disks, magnetic disks, computer tapes, disks, and, [sic] cartridges." ('992 patent, 6:19-22). The specification further states that the library has a geographical location which can be remote from a data base and is remote from a receiving system. ('992 patent, 2:65-66; 6:23-30; and 15:13-15). A transmission system may have more than one library and libraries may communicate with the other libraries in the transmission system. ('992 patent, 6:28-34).

Defendants argue that the structure disclosed in the specification for performing the functions recited in the claim is a source material library, which defendants state are "the original source items available in the transmission system organized in a library." (Defs' Brief at 32:2-5). Defendants' construction does not conform to what the inventors meant by the "source material library" in the specification; defendants are attempting to add limitations to the construction which are not even present in the specification.

Nothing in the specification states that only "original" items are stored in the source material library -- copies of source material items could be stored in one or more of the source material libraries. Further, nothing in the specification states that the items are "organized" in the source material library. The specification contemplates that the items would be assigned a unique identification code and would be organized when they are placed into the compressed data library for access by a user. ('992 patent, 6:35-39). Defendants also do not define what is meant by "library." Defendants argue that the library is not a "generic library," but do not state what they believe "library" should mean. Acacia's construction for "library" -- a place where materials are kept or a collection of such materials is the ordinary and customary meaning of the term and it is consistent with the specification as a place or collection of the materials described at 6:8-22, which includes audio and video tapes, film, and computer tapes, disks, and cartridges.

D. The Phrase "Storing Items Having Information in a Source Material Library" Should Not be Construed to Include a "Readily Accessible" Limitation

The terms in the phrase "storing items having information in a source material library" are used in their ordinary and customary manner and this phrase is construed as:

> the act of placing items having information in a source material library for later use where a source material library is a place where source material is kept or a collection of such material, source material are physical things at the point of origin or

> procurement, items having information are units or members of groups which have information, and information is any meaning assigned to data by known conventions.

Defendants argue that the "source material library" is "not simply an off-site library, such as a public library or a video store that bears no relation to the transmission system." Defendants contend that the written specification of the '992 patent makes this definition clear, but do not cite to the written specification in support of their argument. (Defs'. Brief at 32:20-22). Defendants therefore interpret this claim phrase as meaning that "the transmission system has readily accessible for use original source items of the transmission system in a library." (Defs'. Brief at 32:28 - 33:2). Defendants' argument is easily rebutted by the specification of the '992 patent, which specifically states that the act of retrieving information for items is analogous to taking books off a shelf at the local public library. ('992 patent, 18:53-59).

Although claim 41 of the '992 is a method claim, and therefore its claim limitations must be acts[8] defendants' proposed definition does not state any act. This is peculiar, because the dictionary definition for "storing" earlier provided by defendants—"to place or leave in a location for later use"—describes an act. Defendants inexplicably ignore their own, earlier definition of "storing" and, instead, propose a definition which has no relationship to the ordinary and customary definition of "storing" when an act is being described.

As they did with respect to the library means, defendants attempt to add a limitation that the source material be "readily accessible" to the transmission system. Again, there is nothing in the written specification which either explicitly or implicitly requires that the source material be "readily accessible." This is a construction that defendants have created, but which is not supported by the specification of the '992 patent.

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[8] 35 U.S.C. § 101 (permitting claims on "processes"); Tilghman v. Proctor, 102 U.S. 707, 727 (1880) ("A process is an act, or a mode of acting"); Cochrane v. Deener, 94 U.S. 780, 788 (1876) ("A process is … an act, or a series of acts").

Defendants therefore cannot meet their burden of overcoming the heavy presumption that the term "storing" is given its ordinary and customary meaning. Acacia's construction, which is consistent with the specification, which is consistent with the ordinary and customary meaning of the terms of the claim phrase, and which states an act, is legally correct. Therefore, the Court should adopt Acacia's proposed construction.

E. The Patent Specification Contains Sufficient Corresponding Structure for the "Identification Encoding Means"

The "identification encoding means" is construed as a means-plus-function claim term under 35 U.S.C. § 112, ¶ 6. The structure disclosed in the specification of the '992 patent for performing the functions of (1) retrieving the information in the items from the library means; and (2) assigning a unique identification code to the retrieved information is a person (e.g., system operator) or computer software having identification encoding capabilities, or a combination of both and all equivalents thereto.

Defendants contend that the specification of the '992 patent discloses no structure whatsoever which corresponds to these functions. The issue of whether the specification adequately sets forth structure corresponding to the claimed function must be considered from the viewpoint of one skilled in the art.[9] Intellectual Prop. Dev., Inc. v. UA-Columbia Cablevision of Westchester, Inc., 336 F.3d 1308, 1319

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[9] The Court has not permitted the parties to present expert testimony at this stage of the proceeding and thus neither party has presented expert testimony with their submissions. See, Intel Corp. v. VIA Technologies, Inc., 319 F.3d 1357, 1367 (Fed. Cir. 2003). Further, claim 1 of the '992 patent is presumed valid in all respects, including definiteness, and therefore defendants' must prove their contention that claim 1 is invalid for indefiniteness by clear and convincing evidence, a standard which defendants have not met and cannot meet, because sufficient structure is set forth in the specification. (Id.)

(Fed. Cir. 2003), citing, Budde v. Harley-Davidson, Inc., 250 F.3d 1369, 1376 (Fed. Cir. 2001) ("Whether a patent adequately sets forth structure corresponding to a claimed function necessitates consideration of the disclosure of the specification from the viewpoint of one skilled in the art.")

Defendants argue, with respect to the first function (retrieving the information in the items) that the item itself is not retrieved, but the "information" in the item is retrieved. (Defs'. Brief at 33:18-24 and 34:11-15). Defendants do not cite to any portion of the specification of the '992 patent to support Defendants' construction of the retrieving function.

Acacia contends that the retrieving function is construed as "getting and bringing back a first item from the library means and thereafter getting and bringing back at least one additional item from the library means." Acacia supports its construction with the specification. First, the specification states that the "step of retrieving the information . . . is analogous to taking books off a shelf at the local public library after the person has decided that he or she would like to read them." (Acacia's Brief at 26:25 - 27:4; '992 patent, 18:53-59). Because retrieving the information for items is analogous to taking books off a shelf, then defendants' construction of this function cannot be correct. When a book is taken off of a shelf, the information is retrieved because the book is retrieved. The specification does not say that retrieving the information is analogous to reading the book, which is what defendants are arguing.

Another portion of the specification confirms that the phrase "retrieving the information in the items" means getting and bringing back the item itself. The specification provides an example of retrieved information as being a motion picture film: (Acacia's Brief at 27:4-11; '992 patent, 7:35-37: "If, for example, the retrieved information to be converted from the source material library is a motion picture film.") Because a motion picture film is the item itself ('992 patent, 6:2-22), the retrieved information is the item in its media format.

Defendants do not provide a construction for the second function "assigning a unique identification code to the retrieved information" other than to refer the Court to their construction of "unique identification code" elsewhere in their brief. Acacia construes this function as "for a first item, symbols are designated which uniquely identify the first items and, for at least one additional item, other symbols are designated to uniquely identify that additional item."

Defendants' contention that there is no structure disclosed for these two functions is wrong. The specification of the '992 patent identifies two structures for performing these functions—a person such as a system operator and an identification encoder 112. First, the specification uses an analogy to communicate that a person would be "the structure" for retrieving information for items:

> As illustrated in FIG. 7, the first step of the distribution method 400 involves retrieving the information for selected items in the source material library 111, upon a request by a user of the distribution system (step 412). This is analogous to taking books off a shelf at the local public library after the person has decided that he or she would like to read them.

('992 patent, 18:53-59; emphasis added).

For items which cannot be handled by a person, such as computer files, the specification identifies software for performing this function. ('992 patent, 17:54-64: "The system may also preferably include dispatching control software . . . The dispatch software may also coordinate . . . source material library 111 utilization.")

The specification further teaches that a person (system operator) and an identification encoder 112 perform the function of assigning a unique identification code. The specification states that the unique identification code is assigned as part of "storage encoding." ('992 patent, 6:39-41). Storage encoding is performed by identification encoder 112 (Id.) and by the system operator (e.g., a person) ('992 patent, 8:42-45; 10:58-61; and 11:13-17).

Defendants argue that an identification encoder has no meaning to those of skill in the art, because defendants cannot find the phrase "identification encoder" in the

IEEE dictionary. The term "encoder" is defined in the IEEE dictionary as: "(2) a device that performs encoding and (3) a device or system that encodes data." (The New IEEE Standard Dictionary of Electrical and Electronics Terms, Fifth Edition (1993) at 437; Exhibit 25 to Supp. App.) "Encode" is defined as "to apply the rules of a code." (IEEE Dictionary, Fifth Edition, at 436; Exhibit 25 to Supp. App.) It is easy to comprehend from this definition that an identification encoder is a device capable of expressing a number symbol, or name that uniquely identifies certain information, as proposed by Acacia. (See, Miller Decl., Exhibit T at 556). See, S3 Inc. v. Nvidia Corp., 259 F.3d 1364, 1371(Fed. Cir. 2001) (reversing district court by holding that a "selector" was adequately disclosed as corresponding structure for the "means . . . for selectively receiving" although the electronic structure and operation of the selector were not described in the specification because "[i]t is not the criterion for compliance with § 112, whether a lay person having no skill whatsoever in this field would know how a selector is constructed.")

Further, there are prior art references which show that the term "identification encoder" was used by those skilled in the art consistent with the use by the inventors in the specification of the '992 patent. Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1584 (Fed. Cir. 1996) ("[a] court in its discretion may admit and rely on prior art proffered by one of the parties, whether or not cited in the specification or the file history. This prior art can often help to demonstrate how a disputed term is used by those skilled in the art. Such art may make it unnecessary to rely on expert testimony and may save much trial time.") U.S. Patent No. 4,087,753 to Paul discloses an "identification encoder:" "The identification encoder 54 encodes the vehicle identification code[10] in the transmit signal (S_T) and subsequently transfers the encoded signal through the signal controller 56 to the vehicle transmit coupling 58 via the signal paths 72 and 74, respectively." (Paul, 14:39-43; Exhibit 22 to Supp. App.)

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[10] It is worth noting in Paul that, with respect to the claim phrase "unique identification code," discussed in the next section, the phrase "vehicle identification code" is used consistently with the inventors' use of "unique identification code:" "the vehicle identification codes may be any particular code or designation which uniquely identifies each vehicle . . ." (Paul, at 8:48-61; emphasis added; Exhibit 23 to Supp. App.)

Thus, the specification contains sufficient structure under 35 U.S.C. § 112, ¶ 6. Atmel Corp. v. Information Storage Devices, Inc., 198 F.3d 1374, 1382 (Fed. Cir. 1999) ("All one needs to do in order to obtain the benefit of [§ 112, ¶ 6] is to recite some structure corresponding to the means in the specification. . . . The requirement of specific structure in § 112, ¶ 6 thus does not raise the specter of an unending disclosure of what everyone in the field knows that such a requirement in § 112, ¶ 1 would entail.") S3, Inc., 259 F.3d at 1371.

F. The Phrase "Unique Identification Code" Should Not Be Construed

The phrase "unique identification code" is used consistent with its ordinary and customary meaning. The phrase is used to describe any code, which is unique and which identifies, and this phrase should be construed as "symbols used to identify, such symbols being unique in the sense that no two identification codes are identical when assigned."[11]

Defendants define the phrase "unique identification code,"[12] in part, by stating what it is not—i.e., it is not a file name or address, popularity code, program note, item title, or unique address code. Defendants are improperly importing limitations from the specification to unduly narrow the meaning of this phrase.

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[11] The ordinary and customary meaning of the phrase "unique identification code" proposed by Acacia is strikingly similar to the definition of the phrase "unique identification code" in the context of power plants, which is set forth in the IEEE Dictionary, submitted by defendants at Exhibit R, page 551. The IEEE Dictionary defines the phrase "unique identification code" as "[a] code applied at the component function level to uniquely distinguish a specific function within a specific system from all other similar or different functions occurring within the system or facility." Conforming this definition from the context of power plants to the context of the '992 patent, the phrase "unique identification code" means "a code assigned to an item to uniquely distinguish the item from all other items within the transmission system." This definition is consistent with the discussion in the specification of the phrase "unique identification code" and therefore further confirms the legal correctness of Acacia's proposed construction.

[12] Throughout their brief, defendants' use the acronym "UIDC" in place of the claim phrase "unique identification code." Nowhere in the claims or specification of the '992 patent is this acronym used. Defendants are not using this acronym merely as shorthand for the phrase "unique identification code." Instead, they are attempting to improperly give the appearance that the "unique identification code" is a specific code and not merely a phrase comprised of terms describing any code which is unique and which identifies.

There is a heavy presumption that the phrase "unique identification code" carries its ordinary and customary meaning (set forth above).[13] CCS Fitness, 288 F.3d at 1366. The inventors used the phrase in the specification consistent with this ordinary and customary meaning. In the specification, the unique identification code is described as a code assigned to an item which is used: (1) to make files addressable ('992 patent, 10:28-30); (2) to permit a user to have access to an item ('992 patent, 11:22-25); and (3) to permit a user to request transmission of a selected item ('992 patent, 14:22-26).[14] Thus, the specification is consistent with the ordinary and customary meaning of the phrase "unique identification code."[15]

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[13] There are prior art references which use the phrase "unique identification code" consistent with the inventors' use of the phrase in the '992 patent. Vitronics, 90 F.3d at 1584. In Gifford, U.S. Patent No. 4,873,626, the phrase "unique identification code" is used to describe an address: "[e]ach processing element 42 has a unique identification code number, which constitutes its address in network 16." (Gifford, at 19:24-26; Exhibit 24 to Supp. App.). In Marinelli, U.S. Patent No. 4,884,208, the "unique identification code is in the form of a standard binary number or binary coded decimal number which has been permanently burned into the PROM 32." (Marinelli, at 3:45-53; Exhibit 25 to Supp. App.)

[14] Defendants themselves describe the unique identification code in their opening brief as generally being a code that is assigned to an item and used by the system to identify the item. (Defs'. Brief at 36:5-11). They further describe the unique identification code as being unique in the sense that it may be assigned to the one group of information retrieved from an item at any one time. (Defs'. Brief at 36:12-15). Although defendants later describe the references in the specification to the file name or address, popularity code, program note, title, and unique address code, they were fully capable of showing that the specification describes and supports the broad concept that the phrase "unique identification code" applies to any code assigned to the item which performs those functions.

[15] Defendants propose a definition for "unique identification code" which is inconsistent with the ordinary and customary meaning of the phrase. In particular, defendants argue that the phrase "unique identification code" does not include a file name or address, popularity code, program note, title, or a unique address code. Interestingly, the phrase "unique identification code" is used in the Wilson patent consistently with the inventor's use of the phrase in the '992 patent. In Wilson, the phrase unique identification code is described as being in the form of a digital address. (Wilson, at 39:59-61; Miller Decl., Exhibit H at 375). The patent examiner cited Wilson during the prosecution of the '720 patent, as Acacia discussed in Section

First, defendants argue that the specification demonstrates that the inventors used the phrase "unique identification code" to describe a code that performs a particular set of functions and does not perform other functions which are not implicit in the definitions of the words "unique," "identification," and "code." (Defs' Brief at 36:27-37:2). Defendants do not cite to the specification to support this proposition nor do they explain what functions are or are not performed.

Next, defendants select portions of the specification and argue that the unique identification code is something other than a file name or address, popularity code, program note, title, or a unique address code (Defs'. Brief at 37:2-20). From these selected portions, defendants' argue only that it is "implicit" from the specification that a "unique identification code" is not the same as a "file address," "popularity code," or a "program note." (Defs'. Brief at 37:9-11). Johnson Worldwide Associates, Inc. v. Zebco Corp., 175 F.3d 985, 992 (Fed. Cir. 1999) ("Mere inferences drawn from the description of an embodiment of the invention cannot serve to limit claim terms.")

All of the portions of the specification selected by Defendants, however, are only preferred embodiments of the invention. (See, '992 patent, 6:48-54: "In a preferred embodiment of the present invention. . ."[16]; 10:46-50: "Stored items are preferably accessed . . ."; and 11:22-25: "A user may preferably access an item . . ."; emphasis added).

Although the patent specification describes many different preferred embodiments of the invention, there are two statements in the specification with respect to the phrase "unique identification code" which are mandatory—"[p]rior to

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III.A.1., supra. Kumar v. Ovonic Battery Co., Inc., 351 F.3d 1364 (Fed. Cir. 2003) (prior art cited in the prosecution history of a patent constitutes intrinsic evidence and therefore can be used to define a term in a patent claim).

[16] It is worth noting that defendants omitted this phrase "In a preferred embodiment of the present invention . . ." from their quote at 37:5-9 of their brief.

being made accessible to a user of the transmission and receiving system of the present invention, the item must be stored in at least one compressed data library 118, and given a unique identification code by identification encoder 112" ('992 patent, 6:35-39) and "[t]he file is addressable through the unique identification code assigned to the data by the identification encoder 112" ('992 patent, 10:28-30). Nothing in these mandatory statements in the '992 patent limits the phrase "unique identification code" in any manner. Therefore the phrase "unique identification code" in the claims cannot be narrowed, as defendants attempt to do, by importing a limitation from one or more of the preferred embodiments. Karlin Technology Inc. et al. v. Surgical Dynamics, Inc., 177 F.3d 968, 973 (Fed. Cir. 1999) ("The general rule, of course, is that the claims of a patent are not limited to the preferred embodiment, unless by their own language."); Electro Medical Systems, S.A. v. Cooper Life Sciences, Inc., 34 F.3d 1048, 1054 (Fed. Cir. 1994) ("Thus, although the specifications [sic] may well indicate that certain embodiments are preferred, particular embodiments appearing in a specification will not be read into the claims when the claim language is broader than such embodiments.").

The fact that the inventors described other possible "unique identification codes" in the specification, such as file names or addresses, popularity codes, program notes, item titles, or unique address codes[17] only shows that the inventors intended the phrase "unique identification code" to be broadly construed.

Defendants further argue that the claim language also supports its contention that a "unique identification code" is different from a file name or address. Defendants argue that claim 1 states that the compressed information for one item may be stored as multiple files with the single assigned unique identification code. Defendants appear to interpret the phrase "storing as files" in the phrase "compressed data storing means" as meaning that each compressed data block for an item is separately stored as a file and that each of these files is stored with the same unique identification code assigned to the item. As discussed in Acacia's opening brief, this cannot be the interpretation of this phrase of claim 1, because the phrase "compressed, sequenced data blocks" refers to the data blocks for a single item, which are placed in a single file. (See, Acacia's Brief at 34:21 - 36:1). The claim uses the term "files" to mean that multiple items are acted upon by the transmission system and that therefore multiple files (one for each item) are stored in the compressed data storing means. Id.

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[17] Defendants argue that unique address codes are assigned by a system operator whereas unique identification codes are assigned by an identification encoder. The specification states that "storage encoding" is performed by identification encoder 112. ('992 patent, 39-41). One purpose for storage encoding is assigning a unique identification code to the item. ('992 patent, 6:39-43). The specification also states "[t]he unique address code is an address assigned to the item by the system operator during storage encoding,. . ." ('992 patent, 10:58-59). Thus, these sections of the specification support that storage encoding is performed by both an identification encoder 112 and a system operator, and does not mean that there is a difference in how a unique identification code or a unique address code are assigned.

Defendants further argue that the fact that the inventors did not use the phrases "file names" or "file addresses" in the claims means the phrase "unique identification code" cannot include file names or file addresses. The opposite is true. The phrase "unique identification code" is broad enough to include "file names" and "file addresses" (file names and file addresses being codes, which can be unique and which can identify), but the phrases "file names" and "file addresses" are more specific, and therefore more narrow, and would not include "unique identification codes." Therefore, the fact that the inventors used the broad phrase "unique identification code" instead of the more narrow phrases "file name" or "file address" (or even popularity code, program note, item title, or unique address code) shows the inventors' intent to use a broad claim phrase which would encompass all unique identification codes, such as file names and file addresses (and even popularity codes, program notes, item titles, or unique address codes), rather than exclude them. See, e.g., Renishaw, 158 F.3d at 1249-1250 ("Nor may we, in the broader situation, add a narrowing modifier before an otherwise general term that stands unmodified in a claim. For example, if an apparatus claim recites a general structure (e.g., a noun) without limiting that structure to a specific subset of structures (e.g., with an adjective), we will generally construe the claim to cover all known types of that structure that are supported by the patent disclosure.") (internal citations omitted).

Defendants have thus failed to meet their burden of overcoming the heavy presumption that the phrase "unique identification code" is not given its ordinary and customary meaning. Acacia's construction, which is consistent with the specification and is consistent with the ordinary and customary meaning of the phrase, is legally correct. Therefore, the Court should adopt Acacia's proposed construction.

G. The Phrase "Sequence of Addressable Data Blocks" Cannot Be Construed Using a Dictionary Definition, Because the Inventors Acted as Their Own Lexicographers

The inventors acted as their own lexicographers in defining the phrase "sequence of addressable data blocks" to mean:

> a series of digital data bytes which represent frames of video data and/or samples of audio data wherein relative time markers assigned to the audio and/or video data makes the frames of video data and/or samples of audio data addressable within a particular item of information.

Defendants argue that the phrase "sequence of addressable data blocks" is given the dictionary definitions of the separate terms "sequence," "addressable," and "data blocks." The dictionary definitions of these terms, however, are inconsistent with the meaning given this phrase by the inventors in the patent specification. Defendants' proposed definition, therefore, cannot be correct. Renishaw, 158 F.3d at 1250 ("[a] common meaning, such as one expressed in a dictionary, that flies in the face of the patent disclosure is undeserving of fealty."); Brookhill-Wilk, 334 F.3d at 1300; Altiris, 318 F.3d at 1374.

The phrase "sequence of addressable data blocks" is used in claim 1 with respect to the ordering means: "ordering means, . . . , for placing the formatted data into a sequence of addressable data blocks" and similarly in claim 41: "placing the formatted data into a sequence of addressable data blocks." Thus, to understand the meaning of the phrase "sequence of addressable data blocks," one should examine the portions of the specification which discuss the ordering means and how formatted data is placed into a sequence of addressable data blocks, which are discussed in the specification of the '992 patent at 7:59 - 8:56.

Defendants' only citation to the specification to support its dictionary definition of "sequence of addressable data blocks" is to Figure 8e and 19:57-60.[18] This figure and portion of the specification do not discuss the "ordering means" or how formatted data is placed into a "sequence of addressable data blocks." Defendants' citation does not even use the phrase "sequence of addressable data blocks." One would not look only to Figure 8e and 19:57-60 to determine the meaning of "sequence of addressable data blocks," as defendants have. One must also look to the portion of the specification discussing the ordering means and discussing how formatted data is placed into a sequence of addressable data blocks—7:59 - 8:56.

Defendants therefore ignore the portions of the specification which discuss the ordering means and the sequence of addressable data blocks. These portions of the specification explicitly state that placing the formatted data into a sequence of addressable data blocks is achieved using time encoding: "The processing also preferably includes . . . placing the formatted data into a sequence of addressable data blocks by ordering means 114 (step 413c) [Item 114 is shown in Figure 2a as "time encoding"]. ('992 patent, 18:68-19:4; emphasis added; See also, 7:66 - 8:1).

In other words, the specification makes clear that the ordering means, which places the formatted data into a sequence of addressable data blocks, performs time encoding using a time encoder.[19] As discussed in Acacia's opening brief: "[t]he preferred addressing scheme employs time encoding." ('992 patent, 8:1-2). Thus, the inventors acted as their own lexicographers by defining the addressing scheme in the phrase "sequence of addressable data blocks" as time encoding.

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[18] Figure 8e does not show a "sequence of addressable data blocks," as that term is used in the claims. Defendants' citation states: "Figure 8e shows methods of distribution to reception systems 200 with both multiplexed and non-multiplexed signal paths, both addressed and non-addressed blocks of items." ('992 patent, 19:57-60). Figure 8e shows how blocks are transmitted, and, in fact, Figure 8e shows that the same block may be transmitted over different distribution channels. ('992 patent, 19:66-68). Further, the address of the blocks shown in Figure 8e is the receiver address. ('992 patent, 19:68 - 20:2). The receiver address is not what makes the sequence of data blocks "addressable."

In its opening brief, Acacia showed that the inventors described in the specification: (1) how the time encoder achieves time encoding by assigning relative time markers to the series of audio samples and audio frames from the converter ('992 patent, 8:7-19); (2) how a video frame is an example of a data block of video data ('992 patent, 19:40-43; Fig. 8a); (3) how an audio sample is an example of a data block of audio data ('992 patent, 19:44-47, Fig. 8b); and (4) how the addressing scheme provided by time encoding provides addressability of the data blocks/frames within an item and makes items addressable throughout the transmission system ('992 patent, 8:20-26; 8:34-36, and 8:50-52). Acacia also showed that this addressing scheme described in the specification by the inventors for the "sequence of addressable data blocks" is different than that provided in a dictionary definition and is different than the other addressing schemes used to locate a file stored in the compressed data library ('992 patent, 10:26-30) and used to identify the address of the user requesting the item ('992 patent, 12:24-25).

To interpret the phrase "sequence of addressable data blocks" as being the dictionary definition of the individual phrases "sequence," "addressable," and "data blocks," without reference to the portions of the specification discussing the ordering means or the time encoder, as defendants do, invites the Court to commit error in interpreting this phrase. Renishaw PLC, 158 F.3d at 1250 (Fed. Cir. 1998) ("[A] common meaning, such as one expressed in a relevant dictionary, that flies in the face of the patent disclosure is undeserving of fealty.")

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[19] In the Introduction to their brief (Section I.C.), defendants state that the ordering means places the formatted data into a "sequence of addressable data blocks." (Defs.' Brief at 14:3-5). Defendants then argue that the time encoder is not part of the ordering means: "[a]fter the data is placed in this sequence [by the ordering means], the data blocks are addressed by time encoder 114. This time encoding process, which is not claimed in claims 1 or 41, . . ." (Defs.' Brief at 5-6, citing, '992 patent, 7:62-63). This is incorrect, because the portion of the specification relied upon by defendants (7:62-63; emphasis added) states that: "the ordering means in the preferred embodiment includes time encoder 114." Thus, if the ordering means places the formatted data into a "sequence of addressable data blocks" and if the ordering means includes time encoder 114, then it is correct that the time encoder places the formatted data into a "sequence of addressable data blocks." It is certainly incorrect, as defendants argue, that the time encoder is not part of the ordering means.

The specification cannot support defendants' proposed definition: "a continuous series of memory units that contain digital information that can be given an identifier" and therefore this construction cannot be correct. (Id.) Thus, the heavy presumption that the phrase "sequence of addressable data blocks" is given its ordinary and customary meaning is overcome.

Accordingly, when examining all of the relevant portions of the specification, it is evident that the inventors acted as their own lexicographers when they used the phrase "sequence of addressable data blocks" in the claims of the '992 patent.

H. The '992 Patent Specification Contains Sufficient Corresponding Structure for the "Compressed Data Storing Means"

The phrase "compressed data storing means" is construed as a means-plus-function claim phrase under 35 U.S.C. § 112, ¶ 6. The structure disclosed in the '992 patent specification for performing the function of storing as files the compressed, sequenced data blocks with the assigned unique identification code is a compressed data formatter and a compressed data library, i.e., a large capacity storage or mass storage device, and all equivalents thereto.

Defendants' argument is contained in the IWI/Offendale brief. Defendants' contend that the specification fails to "clearly identify" structure corresponding the "compressed data storing means." Defendants do not argue that the specification lacks structure; they only argue that the structure that is disclosed in the specification is not "clearly identified" as corresponding to the "compressed data storing means." The issue of whether the specification adequately sets forth structure corresponding to the claimed function must be considered from the viewpoint of one skilled in the art.[20] Intellectual Prop., 336 F.3d at 1319.

Defendants state that the specification of the '992 patent only uses the term "compressed data storing means" twice and argue that the "compressed data storage means" (also used in the specification) cannot be the same as the "compressed data storing means."

The specification of the '992 patent makes clear that the claimed "compressed data storing means" is comprised of the "compressed data storage means." This is evident from the fact that the specification describes the function of the "storing" means as "storing as a file the compressed sequenced data with the unique identification code received from the data compression means." ('992 patent, 10:19-22). This function necessarily includes two acts—(1) formatting the data into a single file and (2) placing the file into storage for later use. (See, '992 patent, 10:23-39). The specification then identifies the "storage" means as performing these two acts using the compressed data formatter 117 and the compressed data library 118.[21] ('992 patent, 7:48-58; 10:23-45; 12:32-57; 12:65-69; 13:1-28; Fig. 2a, Item 117; Fig. 2b, Item 118). Thus, the structure identified in the specification for performing the claimed function is the compressed data formatter and the compressed data library.

Defendants contend that the "storing" means cannot be synonymous with the "storage" means, citing Ethicon Endo-Surgery, Inc. v. United States Surgical, Inc., 93 F.3d 1572, 1579 (Fed. Cir. 1996). The Ethicon case is easily distinguished, however, because, in that case, the two items at issue were structural and the terms "bar" and "assembly" clearly have different scope. Ethicon, 93 F.3d 1572, n.4 ("we note in passing that the word 'assembly' itself implies a multi-component apparatus.") Here, the two items at issue are "means" terms in the specification and the terms "compressed data storing means" and "compressed data storage means" are of the same scope. Nothing in the specification states that the "storing" means is not the "storage" means and in fact, the specification is clear that the "storing" means is comprised of the "storage" means. ('992 patent, 10:23-39).

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[20] As discussed, supra at fn. 10, the Court has not permitted the parties to present expert testimony at this stage of the proceeding.

[21] Defendants argue that the compressed data library 118 is an "optional" sub-component. The specification states that compressed data library is "preferred." ('992 patent, 10:34-39). The compressed data library is hardly "optional." (See also, '992 patent, 6:35-39).

Another fallacy with defendants' analysis is that defendants' interpretation of the claimed function is incorrect. Defendants attribute functions to the "compressed data storing means" which are not present in claim 1 or supported by the specification. The function stated in the claim is "storing as files the compressed, sequenced data blocks received from the data compression means with the unique identification code assigned by the identification encoding means."

Defendants contend that one of the functions of the "compressed data storing means" is to receive blocks of data that are in sequence from the data compression means. (Defs' Brief at 7:8-9). This is not one of the functions stated in the claim. First, the claim does not recite one of the functions of the "compressed data storing means" as being "receiving." Here, the claim phrase uses the past tense "received from the data compression means." The claim does not say "for storing . . .and for receiving." It only says "for storing." Thus, it is incorrect for defendants to argue that the compressed data formatter 117 and/or the compressed data library do not receive the compressed, sequenced data blocks.

Defendants further argue that the compressed data library is not "coupled to" the data compression means. Coupling to the data compression means is not one of the functions of the "compressed data storing means" recited in the claims. Further, the specification does state that the compressed data storing means is coupled to the data compression means. ('992 patent, 2:41-41 and 10:19-20). With respect to a construction of "coupled to," the parties did not agree to construe this term, and, in fact, it was counsel for IWI who proposed construing this phrase and they specifically excluded "coupled to" from their proposal (Exhibit 19 to Supplemental Appendix).

Further, the claim does not say "blocks of data that are in sequence." The claim uses the phrase compressed, sequenced data blocks. The terms "compressed" and "sequenced" are in their past tense form to merely identify the data blocks which were placed into a sequence of addressable blocks by the ordering means and were compressed by the compression means.

Defendants contend that another function of the "compressed data storing means" is to store the "sequence of data blocks" as multiple files. (Defs' Brief at 7:9). Defendants do not state whether a single file is used to store the data blocks for a single item and that another file is used to store the data blocks for another item, and so on, as shown by Acacia in their brief. (Acacia's Brief at 34:23 - 36:1). As stated in the specification of the '992 patent, the file is addressable through the unique identification code and that each item is given a unique identification code.[22] ('992 patent, 6:35-39 and 10:28-30). Defendants' construction cannot stand, because it is inconsistent with the claim language and inconsistent with the specification. See, Renishaw, 158 F.3d at 1250 ("The construction that stays true to the claim language and most naturally aligns with the patentee's description of the invention will be, in the end, the correct construction.")

Defendants contend that the final function of the "compressed data storing means" is that the files stored include the unique identification code. (Defs' Brief at 7:10-11). The claim states that the compressed, sequenced data blocks are stored "with" the unique identification code. It does not state that the file includes the unique identification code. The specification does not state that the unique identification code is stored in the file, but rather states that the file is addressable through the unique identification code ('992 patent, 10:28-30). The portion of the specification cited by defendants, 6:35-39, does not support defendants' argument. This section merely states that the item is stored in the compressed data library and that the item is assigned a unique identification code. The specification does not state that the unique identification code is stored in the file.[23]

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[22] Defendants argue that the unique identification code is: (1) placed into a predetermined format; (2) placed into a sequence of addressable data blocks; and (3) are compressed. (IWI Brief at 7, n. 2). Defendants do not support this with a cite to the specification of the '992 patent. This is because there is no support for this construction. The unique identification code is not operated on in this manner.

When the correct functions of the claim are applied to the specification, the only conclusion is that the compressed data storing means is a compressed data formatter and a compressed data library.

I. The Phrase "Storing as a File" Is Not Construed Under 35 U.S.C. § 112, ¶ 6

The phrase "storing, as a file, the compressed, formatted and sequenced data blocks with the assigned unique identification code" is construed as:

> the compressed, formatted and sequenced data blocks for a first item are placed into a file (a collection of data or a set of related records treated as a unit which is placed in a location for later use), the file for the first item being addressable through the unique identification code assigned to the first item. Thereafter, the compressed, formatted and sequenced data blocks for at least one additional item are each placed into a file, each file being placed in a location for later use, the file for each additional item being addressable through the unique identification code assigned to each additional item.

This phrase is not a "step-plus-function" claim term requiring construction under 35 U.S.C. § 112, ¶ 6, as defendants contend.

Before addressing the lack of merit to defendants' allegations, the Court must understand the inconsistencies in the arguments regarding claim 41 made by the Fish & Richardson defendants and IWI/Offendale. Defendant IWI's brief is the first time that any defendant in this case has ever contended that the phrases of claim 41, should be construed as a step-plus-function claim phrase pursuant to 35 U.S.C. § 112, ¶ 6. Although IWI submitted a discovery claim chart, they did not address claim 41. (Exhibit 20 to Supp. App.) The defendants represented by Fish & Richardson prepared a discovery claim chart and included claim 41, but they did not contend that any phrase of claim 41 should be interpreted as a step-plus-function claim term. (Exhibit 21 to Supp. App.) The Fish & Richardson defendants were able to interpret every claim phrase in claim 41without resort to step-plus-function analysis. (Id.) Even in their claim construction brief, the Fish & Richardson defendants were able to interpret the phrase "storing items having information in a source material library" of claim 41 without mentioning "step-plus-function" claims or Section 112 (See, Defs' Brief at 32-33).

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[23] Defendants further contend that the unique identification code is assigned prior to the conversion of the information to a predetermined format by the conversion means. (IWI Brief at 12:3-28). As discussed in Acacia's opening brief, nothing in the claim requires that the unique identification code be assigned at that particular time and at no other time. (Acacia's Brief, at 28:14-22 and n. 18).

Defendants' proposed interpretation of this claim phrase as a step-plus-function phrase is without merit. The claim phrase at issue "storing, as a file, . . ." is not interpreted as a step-plus-function claim, because it is not written with the words "step for . . ." Although the term "step" is used in the preamble, the claim does not use the words "step for. . ." Masco Corp. v. United States, 303 F.3d 1316, 1327 (Fed. Cir. 2002) ("Where the claim drafter has not signaled his intent to invoke § 112, paragraph 6 by using the "steps for" language, we are unwilling to resort to that provision to constrain the scope of coverage of a claim limitation without a showing that the limitation contains nothing that can be construed as an act. Method claims are commonly drafted, as in this case, by reciting the phrase "steps of" followed by a list of actions). Like means-plus-function claims with respect to the words "means for . . .", if the words "step for . . ." are not used in the claim, there is a rebuttable presumption that the inventors did not intend to invoke 35 U.S.C. § 112, ¶ 6 and therefore that the phrase is not a step-plus-function claim term. (Id.) Therefore, in this case, the "storing, as a file" claim phrase is presumed to not be construed as a "step-plus-function" claim term.

Defendants have not and can not rebut the presumption that this claim phrase is not a step-plus-function claim. The presumption can be overcome if the claim identifies an act. Seal-Flex, Inc. v. Athletic Track and Court Construction, 172 F.3d 836, 849 (Fed. Cir. 1999), citing, O.I. Corp. v. Tekmar Co., Inc., 115 F.3d 1576, 1583 (Fed. Cir. 1997) ("Therefore, when the claim language includes sufficient acts for performing the recited function, § 112, [paragraph] 6 does not apply.") Here, the term "storing" is such an act. The term "store" is defined as "to place or leave in a location (as a warehouse, library, or computer memory) for preservation or later use or disposal." (Webster's at 1162; Exhibit 12). Storing is an act, not a function. Masco Corp., 303 F.3d at 1327-28 (phrase "transmitting a force" is an act); Seal-Flex, 172 F.3d at 849-850 ("'Acts,' on the other hand, correspond to how the function is accomplished. Therefore, claim interpretation focuses on what the claim limitation accomplishes, i.e., it's underlying function, in relation to what is accomplished by the other limitations and the claim as a whole.")

Although defendants cite three cases which discuss step-plus-function claims, none of those three cases held that that a claim term which does not use the words "step for . . ." shall be construed under 35 U.S.C. § 112, ¶ 6. In all three of the cases, the court found that the claim terms recited acts and therefore none of the claims were step-plus-function claims. Masco Corp., 303 F.3d at 1327-28; Seal-Flex, 172 F.3d at 849-50; O.I. Corp., 115 F.3d at 1583. Defendants therefore have cited no case in which the court held that a claim phrase which did not use the words "step for. . ." is interpreted as a step-plus-function claim term under 35 U.S.C. § 112, ¶ 6.

Defendants argue that, as a result of statements made by the inventors when adding claim 41 to the '992 patent application, claim 41 must have the same scope as claim 1 of the '992 patent. Defendants base this argument on the fact that the inventors had filed a petition to make special and the requirement that the application be directed to one invention. This is a ridiculous argument, because the requirement is for a single invention, not a single claim. The original application, which was found by the Patent Office to be directed to a single invention, contained 32 claims, three of which were independent claims—claim 1 claimed a transmission system, claim 18 claimed a distribution method, and claim 22 claimed a receiving system. Further, each claim in every patent application defines a separate invention and each claim is presumed to have a different scope than every other claim in the patent.

Defendants further argue that the fact that the inventors stated that claim 41 "tracks" claim 1 means that claim 41 must be interpreted as a step-plus-function claim. This, too, is ridiculous, because the inventors did not say that claim 41 should be interpreted as a step-plus-function claim and the claim did not include the words "step for. . ."

Accordingly, this claim phrase is not interpreted as a step-plus-function claim phrase.

IV. CONCLUSION

For the foregoing reasons, and those stated in Acacia's opening brief, Acacia respectfully requests that the Court adopt its claim constructions.

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HENNIGAN BENNETT & DORMAN LLP

By [signature]
Alan P. Block

Attorneys for Plaintiff,
ACACIA MEDIA TECHNOLOGIES CORPORATION

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